REMARKS

In response to the Office Action dated December 17, 2007, the Applicant has amended claims 1, 6, 10, 15 and 18. Claims 1-3, 5-7, 9-13 and 15-20 are in the case. Reexamination and reconsideration of the application, as amended, are requested.

GROUNDS OF REJECTION

The Office Action rejected claims 1-3, 5-7, 9-13 and 15-20 under 35 U.S.C. § 103(a) as being unpatentable over Kawamura et al. (U.S. Patent No. 6,931,138) in view of Kudo et al. (U.S. Patent No. 6,919,925) in view of Kincaid (U.S. Patent No. 7,072,477) and further in view of Nagao (U.S. Patent No. 6,573,909) and still further in view of Kosaka (U.S. Patent No. 6,281,925).

ARGUMENT

A. The rejection of claims 1-3, 5-7, 9-13 and 15-20 under 35 U.S.C. § 103(a) should be withdrawn because these claims contain features that are not disclosed, taught or suggested by the combined cited references.

On page 3 of the December 17, 2007 Office Action, the Examiner rejected claims 1-3, 5-7, 9-13 and 15-20 over Kawamura et al., in view of Kudo et al., in view of Kincaid, and further in view of Nagao, and still further in view of Kosaka.

This rejection under 35 U.S.C. § 103(a) should be withdrawn because all of the features of the Applicant's claimed invention are not disclosed, taught or suggested by the combined cited references. According to case law and the MPEP, all of the claimed elements of an Applicant's invention **must be considered**. (In re Kotzab, 55 USPQ 2d 1313, 1318 (Fed. Cir. 2000). *MPEP 2143.*) [*emphasis added*]. If **one** of the elements of the Applicant's invention is missing from or not taught in the cited references and the Applicant's invention has advantages not appreciated by the cited references, then no prima facie case of obviousness exists. (*MPEP 2143.03).* The Federal Circuit Court has stated that it was error not to distinguish claims over a combination of prior art references where a material limitation in the claimed system and its purpose was not taught therein. In Re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

For example, five references were combined by the Examiner in one rejection. The Examiner argued that the combined cited references disclose a zoom

microphone device (Kawamura et al.), video camera with buttons (Kudo et al.), an audio processing system that alters the audio playback in response to changes in the scene selected by the user (Nagao), creating metadata corresponding to recorded audio (Kincaid) and, as long as an earphone and an external microphone are used for communication, the amplification gains of the amplifiers in a voice processing unit are held unchanged (Kosaka), as argued by the Examiner.

However, the combined references are missing features as specifically claimed with the other elements of the Applicant's claimed invention and do **not** disclose, teach or suggest the Applicant's claimed invention. Namely, the combined references are missing the Applicant's claimed processing circuitry that simultaneously changes the gain of the audio amplifier, but not an audio recording gain of the audio microphone so that the audio recording gain of the audio microphone is kept at a same audio recording level while the zoom levels change during recording of the images.

Although Kosaka discloses that "...as the output sound level and the input sound level are not increased even when the operation mode is switched from the voice communication to the voice and image communication, the user can communicate with the opponent user while watching the image of the opponent user on the display 8 and without disturbing other people around the user", clearly, Kosaka alone or in combination with the other cited reference does **not** simultaneously change the gain of the audio amplifier, **but not** an audio recording gain of the audio microphone and keep the recording gain of the audio microphone at a same audio recording level **while the zoom levels change** during recording of the images.

Therefore, since the combined references are missing features of the Applicant's claimed invention, the combined references cannot render the Applicant's invention obvious. This failure of the cited reference to disclose, suggest or provide motivation for the Applicant's claimed invention indicates a lack of a prima facie case of obviousness and, thus, the rejections should be withdrawn (MPEP 2143).

B. The rejection of claims 1-3, 5-7, 9-13 and 15-20 under 35 U.S.C. § 103(a) should be withdrawn because even though the combined references do not disclose, teach, or suggest all of the features of the Applicant's claimed invention, the references should not be considered together because the Kawamura et al. reference teaches away from the Applicant's claimed invention.

MPEP section 2143.01, part V. clearly states that "[I]f proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Also, MPEP section 2143.01, part VI. states that "[I]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

For instance, Kawamura et al. **requires** a microphone (pickup section as element 11 including microphones 16a and 16b of Kawamura et al.) to pickup and enhance the audio as the zoom level changes. Kawamura et al. **explicitly** disclose that the "...present invention is directed to a ***zoom microphone*** device having an ***audio zooming function*** of effectively ***enhancing a target sound*** in accordance with a zoom position." [***emphasis added***] (see col. 3, lines 6-8 of Kawamura et al.).

However, the Applicant's claimed invention does **not** enhance microphone pickup to adjust volume levels in response to zoom levels. Instead, the Applicant's claimed invention simultaneously changes the gain of the audio amplifier, **but not** an audio recording gain of the audio microphone and keeps the recording gain of the audio microphone at a same audio recording level **while the zoom levels change** during recording of the images. As such, the Applicant's claimed invention uses the sound output of the speakers to adjust volume in response to different zoom levels, but **does not** adjust the gain of the microphone during zooming, which is **required** in Kawamura et al.

As a result, the proposed modification or combination would render Kawamura et al. being modified unsatisfactory for its intended purpose and would change the principle of operation of the invention in Kawamura et al. being modified. Unquestionably, Kawamura et al. explicitly **require** a zoom microphone device to

pickup audio at different zoom levels and enhance the audio of a target as the zoom level changes, **unlike** the Applicant's claimed invention which keeps an audio recording gain of the audio microphone at a same audio recording level while the zoom levels change during recording of the images.

Thus, this "teaching away" prevents this reference from being used by the Examiner. ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). Since the Applicant's claimed elements are **not** disclosed, taught or suggested by the combined references and because Kawamura et al. **teach away** from the Applicant's invention, Kawamura et al. **cannot** be used as a reference alone or in combination with other references, and hence, the Applicant submits that the rejection should be withdrawn. *MPEP 2143.*

C. The rejection of claims 1-3, 5-7, 9-13 and 15-20 under 35 U.S.C. § 103(a) should be withdrawn because the Examiner used impermissible hindsight when he rejected the claims.

It is well-settled law that there must be a basis in the references for combining or modifying the references. Namely, the Examiner **cannot** use a "tack-on" approach to **arbitrarily "pick and choose" elements** from numerous references and combine these elements using hindsight. Any combination of elements in a manner that reconstructs the Applicant's invention only with the benefit of **hindsight** is insufficient to present a prima facie case of obviousness. Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc., 796 F.2d 443, 230 USPQ 416 (Fed. Cir. 1986). [*emphasis added*].

Evidence that the Examiner used hindsight is clearly confirmed by the fact that the Examiner cited five (5) references for a single rejection without providing any reasoning for combining these references. Contrary to the Examiner's approach, the Applicant submits that there must be some reason, suggestion, or motivation found in the references whereby a person of ordinary skill in the field of the invention would make the combination. **That knowledge cannot come from the applicant's invention itself.** In re Oetiker, 977 F.2d 1443, 24 USPQ 2d 1443, 1446 (Fed. Cir. 1992) [*emphasis added*].

Further, "[T]he genius of invention is often a combination of known elements which in hindsight seems preordained. To prevent hindsight invalidation of patent claims, the law requires some 'teaching, suggestion or reason' to combine cited

references." Gambro Lundia AB v. Baxter Healthcare Corp., 110 F.3d 1573, 1579, 42 USPQ 2d 1378, 1383 (Fed. Cir. 1997). When the reference in question seems relatively similar "...**the opportunity to judge by hindsight is particularly tempting**. Consequently, the tests of whether to combine references need to be applied rigorously," especially when the Examiner uses numerous references. McGinley v. Franklin Sports Inc., 60 USPQ 2d 1001, 1008 (Fed. Cir. 2001). [*emphasis added*]. Since the Examiner's rejection is unquestionably based on hindsight, the rejection is improper and must be withdrawn. Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.

Even if the references in question seem relatively similar "...**the opportunity to judge by hindsight is particularly tempting**. Hence, the tests of whether to combine references need to be applied rigorously," especially when the Examiner uses a reference that does not explicitly disclose the exact elements of the invention or **teaches away** from the Applicant's claimed invention, which is the case here. This is because clearly the combined cited references do **not** simultaneously change the gain of the audio amplifier, **but not** an audio recording gain of the audio microphone and keep the recording gain of the audio microphone at a same audio recording level **while the zoom levels change** during recording of the images. McGinley v. Franklin Sports Inc., 60 USPQ 2d 1001, 1008 (Fed. Cir. 2001).

Since hindsight cannot be used to support the rejections, the combined cited references cannot render the Applicant's invention obvious and the rejection is improper and should be withdrawn. Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc. Accordingly, this teaching away and the failure of the cited references to disclose, suggest or provide motivation for the Applicant's claimed invention indicates a lack of a prima facie case of obviousness (MPEP 2143).

Last, with regard to the dependent claims, since they depend from the above-argued respective independent claims, they are therefore patentable on the same basis. (MPEP § 2143.03). Also, the other references cited by the Examiner also have been considered by the Applicant in requesting allowance of the dependant claims and none have been found to teach or suggest the Applicant's claimed invention.

CONCLUSION

In view of the foregoing, reversal of the rejections of the claims is respectfully requested. For any one of the above-stated reasons, the rejections of the respective claims should be reversed. In combination, the above-stated reasons overwhelmingly support such reversal. Accordingly, Applicant respectfully requests reversal of the rejections of the claims.

Respectfully submitted,

Date: March 17, 2008 Attorney: _____

Edmond A. DeFrank
Reg. No. 37,814